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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/787,309	02/27/2004	Masataka Mochizuki	249466US0DIV	4332

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EXAMINER

VORTMAN, ANATOLY

ART UNIT	PAPER NUMBER
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2835

DATE MAILED: 08/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/787,309

Applicant(s)

MOCHIZUKI ET AL.

Examiner

Anatoly Vortman

Art Unit

2835

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 07 July 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 26,34-39 and 44-48.
Claim(s) withdrawn from consideration: 32,33,41-43 and 49.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____.
13. ☐ Other: _____.



Anatoly Vortman
Primary Examiner
Art Unit: 2835

Continuation of 11. does NOT place the application in condition for allowance because:

Applicant's arguments are not persuasive. Applicant contends that "[B]ased on the putty like consistency of the thermoplastic resin of Fredberg, the Applicants submit that it does not bond or integrally join the electronic part and heat sink, since "the device is easily removed from the adhesive" ". Examiner believes that Applicant contradicts to his previous remarks. Applicant has stated earlier that "Fredberg [sic] discloses bonding integrated circuits to heat sinks using a thermoplastic adhesive resin (col. 1, line 42)" (see p.6, lines 9+ of the Amendment). Further, claims recite "bonding or integrally joining", therefore meeting of one of the limitations by the prior art would be sufficient. The gist of the invention of Fredberg is directed to an adhesive composition used to "secure integrated circuits to a heat sink" (column 1, line 42). So, how this is not bonding? Further, courts held that term "integral" (i.e. integrally joined) "may be construed as relatively broad". In re Dike (CCPA) 157 USPQ 581. And "is not necessarily restricted to one-piece article". In re Kohno (CCPA) 157 USPQ 275.

Furthermore, Applicant contends that "cited prior art does not suggest selecting an electronic part and heat sink having coefficients of thermal expansion so close so as to not generate significant thermal stress". This is also not persuasive. Firstly, "so close" terminology is absent from claims 26 and 39. The claims recite "about the same" instead. It appears that claims are broader than argued. Secondly, it was held that term "about" is entitled to latitude in characterizing feature which was not critical to distinction over prior art" In re General Foods Corp. v. Perk Foods Co. (DC. NII) 157 USPQ 14. Thirdly, regarding the coefficients of thermal expansion, as presented in the rejection above, the electronic part (die) (52) and the heat spreader of Ueki et al., are inherently have about (as claimed) the same coefficients of the thermal expansion since it is a goal of any reasonable designer to design a cooling arrangement, which would not be destroyed by the excessive thermal stresses. Therefore, it is inherited in the cooling structure of Ueki et al. to have the electronic part (die) (52) and the heat spreader with about the same coefficients of thermal expansion. Examiner would like to reiterate that the express, implicit and inherent disclosures of a prior art reference may be relied upon in the rejection of claims under 35 U.S.C. 102 or 103. "The inherent teaching of a prior art reference, a question of fact, arises both in the context of anticipation and obviousness." In re Napier, 55 F.3d 610, 613, 34 USPQ2d 1782, 1784 (Fed. Cir. 1995). "[I]n considering the disclosure of a reference, it is proper to take into account not only specific teachings of the reference but also the inferences (emphasis added) which one skilled in the art would reasonably be expected to draw therefrom." In re Preda, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968). "The test for an implicit showing (emphasis added) is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." In re Kotzab, 217 F.3d 1338, 1342-44, 61 USPQ2d 1430.

Furthermore, Applicant contends that "Ueki [...] cannot provide a reasonable expectation of success for the present invention which bonds or integrally joins these elements in a way to minimize thermal stress". This is also not persuasive. Please note, that Ueki et al teaches a cooling arrangement for an integrated circuit comprising a heat sink attached to said integrated circuit and Fredberg teaches an adhesive for bonding a heat sink to an integrated circuit. So, how one of ordinary skill in the cooling art would not anticipate the success of the Ueki et al.- Fredberg combination? Clearly, one of ordinary skill in the cooling art would be reasonably expecting the success of the aforementioned combination. For obviousness under 35 U.S.C. 103, all that is required is a reasonable expectation of success. In re Longi, 759 F.2d 887, 897, 225 USPQ 645, 651-652 (Fed. Cir. 1985); In re Clinton, 527 F.2d 1226, 1228, 188 USPQ 365, 367 (CCPA 1976).

Furthermore, regarding the Official Notice, Applicant contends: "Applicants made no admission with respect to what is well-known prior art and would prefer the record clearly cite such art". On the contrary, Examiner would like to direct the Applicant's attention to the fact that failure by Applicant to seasonably challenge the Examiner's assertion of the Official Notice earlier during prosecution is tantamount to the admission that the well-known statement is a prior art. (MPEP 2144.03 (C)).



Anatoly Vortman
Primary Examiner
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